# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 09/781,253 | 02/13/2001 | Takumi Hasegawa | Q63086 | 8082 |

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| EXAMINER |
|---|
| DAY, HERNG DER |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2128 | |

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/781,253 | HASEGAWA, TAKUMI |
| | Examiner | Art Unit |
| | Herng-der Day | 2128 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>22 June 2006</u>.

2a)☒ This action is **FINAL**.     2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1,2,4-6,8-11,13,14,16,17,19,20 and 23-26</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,2,4-6,8-11,13,14,16,17,19,20 and 23-26</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All  b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

1. This communication is in response to Applicant's Amendment ("Amendment") to Office Action dated March 22, 2006, mailed June 22, 2006.

1-1. Claims 1, 4-6, 8-11, 14, 16, 17, 19, 20, and 23 have been amended. Claims 7, 15, 21, and 22 have been cancelled. Claims 1, 2, 4-6, 8-11, 13, 14, 16, 17, 19, 20, and 23-26 are pending.

1-2. Claims 1, 2, 4-6, 8-11, 13, 14, 16, 17, 19, 20, and 23-26 have been examined and rejected.

1-3. Applicant is advised that should, (1) claim 1 be found allowable, claims 5, 6, and 8 will be objected to; (2) claim 11 be found allowable, claims 13, 14, and 16 will be objected to; and (3) claim 17 be found allowable, claims 19 and 20 will be objected to, under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.      Claims 1, 2, 4-6, 8-11, 13, 14, 16, 17, 19, 20, and 23-26 are rejected under 35 U.S.C.

103(a) as being unpatentable over Berger et al., U.S. Patent 6,414,693 B1 issued July 2, 2002,

and filed October 12, 1999.

3-1.    Regarding claim 1, Berger et al. disclose a user's request reflecting design system for

timely and accurately reflecting users' requests on a product, comprising:

design data publicizing means for publicizing design data to users through a computer

network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6,

lines 39-47);

correction data receiving means for receiving and storing correction data as said design

data corrected by a user through said computer network (the selected GIF file, in its finalized

location within the JPEG bag image file are downloaded to the supplier/system operator for

storage, column 8, lines 2-9); and

design assisting means for reflecting said correction data (coordinate location, column 8,

lines 6-9) received by said correction data receiving means on product design (to maintain its

relative location on the bag when reviewed, column 8, lines 6-9),

Wherein said design data publicizing means includes

public design data prepared in advance to be publicized among said design data (the

stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one

or more Java 'applets' for operation with a Java-compatible web browser on the client's local

computer, column 4, lines 36-42), and

a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6, lines 48-52) for transferring said public design data and said editing program file to said terminal (the screen display 700 of FIG. 7 is generated, column 6, lines 48-52), and

wherein said correction data receiving means includes

a data base for registering said correction data (the database, column 4, lines 1-5), and

a received mail processing unit for receiving an electronic [mail] to which said correction data is attached and registering and storing said correction data in said data base (the database is organized so that each unique user of the service is defined as an 'entity' 200, column 4, lines 1-5; the customized bag order can be associated with a given client, column 8, lines 2-16),

said received mail processing unit classifying said correction data attached and registering said correction data in said data base based on personal information of a user recited in said electronic [mail] (the customized bag order can be associated with a given client and confirmed by return e-mail, column 8, lines 2-16).

Although Berger et al. disclose "the image can be submitted for production by clicking the submit button" (column 7, line 67, through column 8, line 2), i.e., an *electronic submission* to which said correction data is included, Berger et al. fail to expressly disclose receiving an *electronic mail* to which said correction data is attached. Nevertheless, using attachment to an electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail (column 8, lines 2-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger et al. to incorporate the using of electronic mail to obtain the invention as specified in claim 1 because using electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail.

**3-2.** Regarding claim 2, Berger et al. further disclose wherein said design data is three-dimensional data (for example, 3D bag, Fig. 7).

**3-3.** Regarding claim 4, Berger et al. further disclose wherein

said editing program file enables editing of three-dimensional data (for example, 3D bag, Fig. 7).

**3-4.** Regarding claims 5, 6, and 8, all the claimed limitations have already been recited in claim 1 and, therefore, are unpatentable using the same analysis as in claim 1.

**3-5.** Regarding claim 9, Berger et al. disclose a user's request reflecting design system for timely and accurately reflecting users' requests on a product, comprising:

design data publicizing means for publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47);

correction data receiving means for receiving and storing correction data as said design data corrected by a user through said computer network (the selected GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9); and

design assisting means for reflecting said correction data (coordinate location, column 8,

lines 6-9) received by said correction data receiving means on product design (to maintain its

relative location on the bag when reviewed, column 8, lines 6-9),

Wherein said design data publicizing means includes

public design data prepared in advance to be publicized among said design data (the

stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one

or more Java 'applets' for operation with a Java-compatible web browser on the client's local

computer, column 4, lines 36-42), and

a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from

a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6,

lines 48-52) for transferring said public design data and said editing program file to said terminal

(the screen display 700 of FIG. 7 is generated, column 6, lines 48-52), and

wherein said design data publicizing processing unit includes

information entry selecting means allowing a user to select either information entry in the

form of a menu or transfer of said public design data and an editing program file (FIG. 6

provides an information entry selecting means, which allows selection of information entry in the

form of a menu, e.g., menu 604, or transfer of public design data and editing program file by

clicking other buttons, e.g., 606 and 608).

**3-6.**     Regarding claim 10, in addition to those limitations have already been recited in claim 1,

Berger et al. further disclose in creation of said design data by said design assisting means, said

correction data registered in said data base is used (to maintain its relative location on the bag when reviewed, column 8, lines 2-9).

**3-7.** Regarding claim 11, Berger et al. disclose a user's request reflecting design method of timely and accurately reflecting users' requests on a product, comprising the steps of:

publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47);

receiving correction data as said design data corrected by a user through said computer network (the selected GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9); and

reflecting said correction data received on product design (to maintain its relative location on the bag when reviewed, column 8, lines 6-9),

wherein said design data publicizing step includes the step of

in response to a request from a terminal connected to said computer network, transferring public design data prepared in advance to be publicized among said design data and an editing program file for editing said public design data to said terminal (By clicking both buttons 606 and 608, the screen display 700 of FIG. 7 is generated, column 6, lines 48-52), and

wherein said correction data receiving step including the steps of

receiving an electronic [mail] to which said correction data is attached (the image can be submitted for production by clicking the submit button, column 7, line 67, through column 8, line 2), and

classifying said correction data attached and registering said correction data in a data base based on personal information of a user recited in said electronic [mail] (the customized bag

order can be associated with a given client and confirmed by return e-mail, column 8, lines 2-16).

Although Berger et al. disclose "the image can be submitted for production by clicking the submit button" (column 7, line 67, through column 8, line 2), i.e., an *electronic submission* to which said correction data is included, Berger et al. fail to expressly disclose receiving an *electronic mail* to which said correction data is attached. Nevertheless, using attachment to an electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail (column 8, lines 2-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger et al. to incorporate the using of electronic mail to obtain the invention as specified in claim 11 because using electronic mail for transferring information is well known to one of ordinary skill in the relevant art as evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail.

3-8.    Regarding claims 13, 14, and 16, all the claimed limitations have already been recited in claim 11 and, therefore, are unpatentable using the same analysis as in claim 11.

3-9.    Regarding claim 17, Berger et al. disclose a server of a user's request reflecting design system for timely and accurately reflecting users' requests on a product, comprising:

design data publicizing means for publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47); and

correction data receiving means for receiving correction data as said design data corrected by a user through said computer network and storing said correction data (the selected GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9) so as to be usable by design assisting means for reflecting said correction data on product design (to maintain its relative location on the bag when reviewed, column 8, lines 2-9),

Wherein said design data publicizing means includes

public design data prepared in advance to be publicized among said design data (the stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one or more Java 'applets' for operation with a Java-compatible web browser on the client's local computer, column 4, lines 36-42), and

a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6, lines 48-52) for transferring said public design data and said editing program file to said terminal (the screen display 700 of FIG. 7 is generated, column 6, lines 48-52), and

wherein said correction data receiving means includes

a data base for registering said correction data (the database, column 4, lines 1-5), and

a received mail processing unit for receiving an electronic [mail] to which said correction data is attached and registering and storing said correction data in said data base (the database is organized so that each unique user of the service is defined as an 'entity' 200, column 4, lines 1-5; the customized bag order can be associated with a given client, column 8, lines 2-16),

said received mail processing unit classifying said correction data attached and

registering said correction data in said data base based on personal information of a user recited

in said electronic [mail] (the customized bag order can be associated with a given client and

confirmed by return e-mail, column 8, lines 2-16).

Although Berger et al. disclose "the image can be submitted for production by clicking

the submit button" (column 7, line 67, through column 8, line 2), i.e., an *electronic submission* to

which said correction data is included, Berger et al. fail to expressly disclose receiving an

*electronic mail* to which said correction data is attached. Nevertheless, using attachment to an

electronic mail for transferring information is well known to one of ordinary skill in the relevant

art as evidenced by the suggestion of Berger et al. that the customized bag order can be

associated with a given client and confirmed by return e-mail (column 8, lines 2-16).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the teachings of Berger et al. to incorporate the using of electronic mail to

obtain the invention as specified in claim 17 because using electronic mail for transferring

information is well known to one of ordinary skill in the relevant art as evidenced by the

suggestion of Berger et al. that the customized bag order can be associated with a given client

and confirmed by return e-mail.

**3-10.** Regarding claims 19 and 20, all the claimed limitations have already been recited in

claim 17 and, therefore, are unpatentable using the same analysis as in claim 17.

**3-11.** Regarding claim 23, Berger et al. disclose a server of a user's request reflecting design

system for timely and accurately reflecting users' requests on a product, comprising:

design data publicizing means for publicizing design data to users through a computer

network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6,

lines 39-47); and

correction data receiving means for receiving correction data as said design data

corrected by a user through said computer network and storing said correction data (the selected

GIF file, in its finalized location within the JPEG bag image file are downloaded to the

supplier/system operator for storage, column 8, lines 2-9) so as to be usable by design assisting

means for reflecting said correction data on product design (to maintain its relative location on

the bag when reviewed, column 8, lines 2-9),

Wherein said design data publicizing means includes

public design data prepared in advance to be publicized among said design data (the

stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one

or more Java 'applets' for operation with a Java-compatible web browser on the client's local

computer, column 4, lines 36-42), and

a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from

a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6,

lines 48-52) for transferring said public design data and said editing program file to said terminal

(the screen display 700 of FIG. 7 is generated, column 6, lines 48-52),

wherein said design data publicizing processing unit includes

information entry selecting means allowing a user to select either information entry in the

form of a menu or transfer of said public design data and said editing program file (FIG. 6

provides an information entry selecting means, which allows selection of information entry in the

form of a menu, e.g., menu 604, or transfer of public design data and editing program file by

clicking other buttons, e.g., 606 and 608).

**3-12.** Regarding claim 24, Berger et al. further disclose wherein

an electronic mail, to which said correction data is attached, is received at said correction

data receiving means, said electronic mail comprising personal information of the user (the

customized bag order can be associated with a given client and confirmed by return e-mail,

column 8, lines 2-16).

**3-13.** Regarding claim 25, Berger et al. further disclose comprising:

receiving an electronic mail to which said correction data is attached, said electronic mail

comprising personal information of the user (the customized bag order can be associated with a

given client and confirmed by return e-mail, column 8, lines 2-16).

**3-14.** Regarding claim 26, Berger et al. further disclose:

an electronic mail, to which said correction data is attached, is received at said correction

data receiving means, said electronic mail comprising personal information of the user (the

customized bag order can be associated with a given client and confirmed by return e-mail,

column 8, lines 2-16).


*Applicant's Arguments*

**4.**      Applicant argues the following:

**4-1.**    Rejection Under 35 U.S.C. § 102(e)

(1) "Applicant respectfully submits that the disclosure of Berger does not anticipate the claimed invention" (page 14, paragraph 4, Amendment).

(2) "the Examiner has admitted to the deficiencies of Berger, stating in paragraph 5-1 of page 7 of the Office Action" (page 15, paragraph 2, Amendment).

(3) "Although Berger's screen block (602) in FIG. 6 provides for entry of a catalog identifier, and buttons (606 and 608) may be clicked, neither of these two actions would amount to an information entry selecting means which allows selection of information entry in the form of a menu or transfer of public design data and editing program file" (Page 16, paragraph 2, Amendment).

**4-2.** Rejection Under 35 U.S.C. § 103(a)

(4) "There is no teaching or suggestion in Suda of 'classifying said correction data attached and registering said correction data in said data base based on personal information of a user recited in said electronic mail,' as recited by claim 1" (page 17, paragraph 4, Amendment).

(5) "There lacks any suggestion in either Berger or Suda of performing functions based on personal information of a user recited in an electronic mail to which correction data is attached" (page 18, paragraph 2, Amendment).

### *Response to Arguments*

**5.**     Applicant's arguments have been fully considered.

**5-1.**     Applicant's arguments (1) and (2) with respect to claims 1, 2, 4, 11, and 17 have been fully considered but are moot in view of the new ground(s) of rejection in response to Applicant's amended claims.

**5-2.**    Applicant's argument (3) is not persuasive. In fact, FIG. 6 does provide an information entry selecting means, which allows selection of information entry in the form of a menu, e.g., menu 604, or transfer of public design data and editing program file by clicking other buttons, e.g., 606 and 608.

**5-3.**    Applicant's arguments (4) and (5) are not persuasive. Berger et al. do suggest the database is organized so that *each unique user* of the service is defined as an 'entity' 200 (Berger, column 4, lines 1-5) and *the customized bag order can be associated with a given client and confirmed by return e-mail* (Berger, column 8, lines 2-16), which meet the recited limitation "classifying said correction data attached and registering said correction data in said data base based on personal information of a user". Furthermore, using electronic mail for transferring information is well known to one of ordinary skill in the relevant art as also evidenced by the suggestion of Berger et al. that the customized bag order can be associated with a given client and confirmed by return e-mail.

### *Conclusion*

**6.**    Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

7.      Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Herng-der Day whose telephone number is (571) 272-3777. The

Examiner can normally be reached on 9:00 - 17:30.

Any inquiry of a general nature or relating to the status of this application should be

directed to the TC 2100 Group receptionist: (571) 272-2100.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, Kamini S. Shah can be reached on (571) 272-2279. The fax phone numbers for the

organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Herng-der Day
August 7, 2006  Ƕ. D

KAMINI SHAH
SUPERVISORY PATENT EXAMINER